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EXAMINER

LONG, TONYA M

ART UNIT

PAPER NUMBER

3689

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DELIVERY MODE

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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

# Office Action Summary

**Application No.**

10/748,246

**Applicant(s)**

SCHAEFER ET AL.

**Examiner**

FONYA LONG

**Art Unit**

3689

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 13 November 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-5, 7-23 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-5, 7-23 and 25-35 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 31 December 2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

This communication is a second Non-Final Office Action rejection in response to communications received on November 13, 2008. Claims 1, 2, 5, 19, and 33 have been amended. Claims 6 and 24 have been cancelled. Claims 1-5, 7-23, and 25-35 are currently pending and have been addressed below.

#### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 5 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claim recites a "first functional area" and a "second functional area." It is unclear what an "area" is defined to mean. Is an area a specific location in a data repository or a specific subject in which the data relates to? The specification does not provide information as to what an "area" is defined as.

#### ***Claim Rejections - 35 USC § 101***

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 19-23, and 25-35 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. As clarified in *Bilski*, the test for a method claim is whether the claimed method is (1) tied to a particular machine or apparatus, or (2) transforms a particular article to a different state or thing.

There are two corollaries to the machine-or-transformation test. First, a mere field-of-use limitation is generally sufficient to render an otherwise ineligible method claim patent-eligible. This means the machine or transformation must impose meaningful limits on the method claim's scope to pass the test. Second, insignificant extra-solution activity will not transform an unpatentable principle into a patentable process. This means reciting a specific machine or a particular transformation of a specific article in an insignificant step, such as data gathering or outputting, is not sufficient to pass the test.

Claims 19-23 and 25-35 recite a device being used to access and stored data which is considered data gathering or outputting as is determined to be an insignificant extra-solution activity.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States

only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 7, 9-12, 14, 19-22, 25, 27-30, and 31 are rejected under 35

U.S.C. 102(e) as being anticipated by Dingman et al. (7,110,970).

**As per Claims 1 and 19**, Dingman et al. discloses a system and method comprising:

an electronic reference center, wherein data is stored representing best practices for deal due diligence (Claim 11, discloses storing historical best practices from past due diligence exercises);

an electronic digital war room wherein due diligence data is stored and accessed along with due diligence results, and the war room includes at least one of the following legal and financial findings and legal and financial documents (Fig. 15; Claim 1, discloses a virtual war room which stores due diligence data referring to past due diligence exercises that may be accessed by a user);

an electronic data repository containing a checklist of due diligence activities (Claim 8, discloses storing a due diligence project to do list (i.e. checklist));

a machine-accessible storage medium configured to store one or any combination of the electronic reference center, the electronic digital war room, and the electronic data repository (Fig. 15; Col. 24, Lines 40-64, discloses repository storing due diligence information including a dictionary, a tool library, a deal pitch repository, links, and dashboards where the information can be accessed); and

a plurality of network enabled devices configured to access the items stored on the storage medium, and having a display configured to display the accessed items

(Claim 13, Col. 3, Lines 31-56, discloses at least one computer connected to a network in order to access information stored in the repository).

**As per Claims 2 and 20**, Dingman et al. discloses the electronic reference center stored data representing an overview of a deal process (Claim 2, discloses storing data referring to business processes).

**As per Claims 3 and 21**, Dingman et al. discloses the electronic reference center stored data representing a glossary of deal terms (Fig. 15, via due diligence dictionary).

**As per Claims 4 and 22**, Dingman et al. discloses the electronic reference center stored data representing recommended best practices (Col. 25, Lines 19-31, discloses storing the historical "best practices" that the business collates and codifies from past due diligence exercises).

**As per Claims 7 and 25**, Dingman et al. discloses at least one portion of the data in said digital war room is reserved for use by at least one functional team (Claim 1, discloses providing access to due diligence information to due diligence teams).

**As per Claims 9 and 27**, Dingman et al. discloses the data stored in the digital war room representing a list of milestones to be reached after the conclusion of a deal (Claim 4, discloses storing due diligence project timeline with milestones and tasks).

**As per Claims 10 and 28**, Dingman et al. discloses a user interface for browsing said data in said digital war room, wherein said user interface comprises a link to said electronic reference center (Col. 24, Lines 10-34, discloses a centralized database that

is stored on a database server and is accessed by users at one of the computers (i.e. user interface) by logging onto server sub-system through one of the computers).

**As per Claims 11 and 29**, Dingman et al. discloses a link to data in said reference center corresponding to the data in said digital war room that appears with said link (Col. 24, Lines 40-50, discloses the virtual war room having links where overviews regarding due diligence information can be accessed).

**As per Claims 12 and 30**, Dingman et al. discloses a data repository containing data obtained as a result of a due diligence process (Col. 24, Lines 40-50, discloses providing a results area which includes previously stored results of prior due diligence exercises including bid results).

**As per Claims 14 and 31**, Dingman et al. discloses a list of contacts (Claim 7, discloses storing contact information of due diligence team members).

### ***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 5, 8, 13, 15-18, 23, 26, and 32-35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dingman et al. in view of Fredell et al. (6,678,698).

**As per Claims 5 and 23**, Dingman et al. discloses the claimed invention as applied to Claims 4 and 22, above. However, Dingman et al. fails to explicitly disclose data being available to a user in a separated format.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of data being available to a user in a separated format, wherein best practices for a first functional area are available to said user separately from best practices for a second functional area (Col. 7, Line 52 – Col. 8, Line 2, discloses storing a plurality of distinct projects in a database (i.e. a separated format) wherein a project participant is given access to the projects assigned to the participant).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include data being available to a user in a separated format as taught by Fredell et al. in order to provide security measures for accessing data stored.

**As per Claims 8 and 26**, Dingman et al. discloses data relating to integrating a first company or an asset into a second company (Col. 24, Lines 40-64, discloses a virtual war room containing data about former and current deals for acquiring a portfolio of assets). However, Dingman et al. fails to explicitly disclose data being reserved for an integration team.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of at least a portion of said data in the digital war



room is reserved for an integration team (Col. 7, Line 52- Col. 8, Line 2, discloses data being reserved for participants (i.e. teams) of a specific project by restricting access).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include data being reserved for an integration team as taught by Fredell et al. in order to provide security measures for accessing data stored.

**As per Claim 13**, Dingman et al. discloses the claimed invention as applied to Claim 12, above. However, Dingman et al. fails to explicitly disclose said electronic data room being used by a first company, and said data obtained as a result of a due diligence process that was obtained from a second company.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of said electronic data room being used by a first company, and said data obtained as a result of a due diligence process that was obtained from a second company (Col. 12, Lines 17-37, discloses participants of the due diligence process using the system includes both the acquiring company and the acquired company).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include said electronic data room being used by a first company, and said data obtained as a result

of a due diligence process that was obtained from a second company in order to provide access to information stored to all parties involved is the acquisition.

**As per Claims 15 and 32**, Dingman et al. discloses the claimed invention as applied to Claims 1 and 19, above. However, Dingman et al. fails to explicitly disclose a means for authenticating entry into said room.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of a means for authenticating entry into said room (Col. 7, Line 52 - Col. 8, Line 2, discloses a sign-on module which contains data comprising a unique "sign-on" authentication credential to allow a participant to access via a single "sign-on" action each distinct project to which that project participant has been approved).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include a means for authenticating entry into said room in order to provide security measures for accessing data stored.

**As per Claims 16 and 33**, Dingman et al. discloses the claimed invention as applied to Claims 15 and 32, above. However, Dingman et al. fails to explicitly disclose permitting some users to edit a portion of said data and prevent other users from editing said portion of said data.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of permitting some users to edit a portion of said

data (Col. 2, Line 54 – Col. 3, Line 10, discloses any project participant being able to download a document to which he/she has access, make modifications and upload modified documents with comments to the storage facility) and prevent other users from editing said portion of said data (Col. 2, Line 54 - Col. 3, Line 10, discloses providing read-only capability to selected project participants and preclude upload capability by other selected users).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include permitting some users to edit a portion of said data and prevent other users from editing said portion of said data as taught by Fredell et al. in order to provide security measures for accessing and editing data stored.

**As per Claims 17 and 34**, Dingman et al. discloses the claimed invention as applied to Claims 1 and 19, above. However, Dingman et al. fails to explicitly disclose updating data.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of updating data (Col. 1, Lines 31-40, discloses permitting individuals to update documents).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include updating

data as taught by Fredell et al. in order to maintain current analytical information needed with conducting business analyses.

**As per Claims 18 and 35**, Dingman et al. discloses the claimed invention as applied to Claims 1 and 19, above. However, Dingman et al. fails to explicitly disclose a user having the option of posting messages regarding a particular piece of said data.

Fredell et al. discloses a method and system for communicating and managing project information with the concept of a user having the option of posting messages regarding a particular piece of said data (Col. 3, Lines 39-41, discloses a posting module which is configured to post over the global communications network to selected participants information).

Therefore, from the teaching of Fredell et al., it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method and system for collaborating on due diligence issues of Dingman et al. to include a user having the option of posting messages regarding a particular piece of said data as taught by Fredell et al. in order to eliminate the use of paper and substantial resources by provide a secure electronic means for posting messages.

**Examiner Note:** Claims 1-5, 8, 9, 12, 14, 19-23, 26, 27, 30, and 31 are directed to non-functional descriptive material. The claims recite the storing of data. The specific type of data being stored does not change the function of the claimed invention. Examiner contends that the system and method of Dingman et al. is fully capable of storing the data recited in the claimed invention.

***Response to Arguments***

9. Applicant's arguments filed November 13, 2008 have been fully considered but they are not persuasive.

**As per Claims 1 and 19**, Applicant argues that Dingman fails to disclose an electronic data room having at least "the war room includes at least one of the following legal and financial findings and legal and financial documents." Examiner respectfully disagrees. Dingman discloses a virtual war room which stores due diligence data referring to past due diligence exercises that may be accessed by a user (Fig. 15; Claim 1). Examiner asserts the type of information being stored in the war room is considered non-functional descriptive material. The type of information being stored in the war room does not change the function of storing and accessing information stored in the war room.

**As per Claims 2-5, 7-18, 23, 26, and 32-35**, Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

***Conclusion***

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to FONYA LONG whose telephone number is (571)270-5096. The examiner can normally be reached on Mon-Thur 7:30am-6:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janice Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Examiner, Art Unit 3689

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